

REMARKS

Claims 1-34 are pending in the present application. In light of the following remarks, Applicants earnestly solicit favorable reconsideration.

As indicated in Applicants interview summary dated September 24, 2008, the Examiner has agreed to issue a new non-final office action (or allow the application) in light of the interviews held on September 18 and 19, 2008. Further, Applicants called the Examiner on September 30, 2008 in order to clarify the Examiner's Interview Summary dated September 29, 2008. In that interview, the Examiner again indicated he would withdraw the present rejection and issue a non-final office action (or allow the application) upon receiving a formal written response from Applicants.

As such, Applicants submit the following comments responding to each of the rejections in the office action dated August 20, 2008.

Claim Rejections - 35 U.S.C. § 101

Claims 11 and 12 stand rejected under 35 U.S.C. § 101 because the claims allegedly are directed to non-statutory subject matter. It appears the Examiner contends that the claims are directed toward a "signal." However, claim 11 clearly is directed towards a "computer readable recording medium." As such, Applicants submit that the claim is statutory subject matter under 35 U.S.C. § 101.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 4, 11 and 25 remain rejected under 35 U.S.C. § 112, second paragraph, as failing to comply with the written description requirement. Applicants respectfully disagree with the Examiner.

During the interview conducted on October 3, 2007, the Examiner's supervisor¹ suggested that the word "automatically" be put into the claims in order to make clear that the recited feature was not performed by a person.

Applicants respectfully submit that the Examiner's present position is unreasonable with respect to the present interpretation of the claims. Specifically, the Examiner contended that a person could perform the required features of the claims, thus the rationale for adding the term "automatic." However, as is readily apparent by a review of the specification, a person does not perform any of the recited features of the claims. On the contrary, each of the recited operations is performed by the apparatus itself.

Thus, if it is apparent that a person does not perform the recited feature, then it must be done automatically. Applicants note that according to the MPEP "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure."²

¹ Thai Tran

² MPEP 2163 (B).

Thus, the disclosure that the features are performed automatically, is *implicitly* disclosed in the present specification. This comports with the MPEP's written description requirement. As such, Applicants respectfully ask that the rejection be withdrawn.

On the Merits

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Nakata et al.* (US 2003/0091329).

During an interview held with the Examiner and his supervisor on October 3, 2007, the Examiner's supervisor used a very broad interpretation of the reference in order to allegedly disclose the mentioned claims.

Specifically, the Examiner argued that a human being could perform some of the various features recited in the claims. As such, the Examiner stated that if the term "automatically" was included in the claims, this would preclude a human being performing said features.

Said features discussed during the interview with the Examiner included:

means for renewing the display of the time information sequence and the still image sequence by [automatically] synchronizing with the current playback time of the video while playing back the video.... (Claim 1)

means for delivering a scene description data which describes the scene of the video file from the server by [automatically] synchronizing with the video data at a constant transmission rate. (Claim 4)

a process for changing the display of the time information sequence and the still image by [automatically] synchronizing with the current playback time of the video while playing back the video. (Claim 11)

means for delivering a scene description file which describes the scene of the video file described in the video description file from the server by [automatically] synchronizing with said main video data at a constant transmission rate. (Claim 25)

Recall from above that the Examiner argued that because a human being could perform these features, the reference disclosed the claimed invention. The Examiner's supervisor implicitly acknowledged that the reference didn't disclose the features without a human being performing said features. (See Examiner Interview Summary dated October 3, 2007.)

However, Applicants' submit that the Examiner's position is not appropriate. According to a recent case, "the case law precludes a conclusion that a human being is a corresponding structure, or an equivalent to a structure, under 35 U.S.C. § 112, P6."³ Thus, a human being is **not** a structure according to the present case law.

As such, the Office cannot use a human being to disclose features of the claimed invention. Therefore, the Examiner's supervisor's rationale that including the term "automatically" in the claims in order to distinguish from a human being performing the requisite feature, is also inappropriate. That is the claims, according to the Examiner's own interview summary, should not be disclosed by the references as it should not matter whether the term automatically is included in the claims or not, because a human being cannot be part of an apparatus.

³ Default Proof Credit Card System, Inc. v. Home Depot U.S.A., Inc., 412 F.3d 1291 (2005).

Independent Claim 1:

Independent claim 1 requires a video playback unit which comprises 6 elements:

¹video playback means for reading in a designated video file and outputting a video of the video file for playback;

²scene description file read-in means for reading in a scene description file which describes a scene inside the video file;

³means for outputting a time information sequence existing before and after the playback time of the video within time information described in the scene description file;

⁴means for outputting the still image sequence corresponding to the time information displayed, wherein the still image is described in the scene description file;

⁵means for renewing the display of the time information sequence and the still image sequence by synchronizing with the current playback time of the video while playing back the video; and

⁶display means for displaying said video, time information sequence and still image sequence.

Regarding the second element (2) of claim 1, the Examiner submits that it is disclosed in paragraph 173 of *Nakata*. Applicants respectfully traverse this rejection. In paragraph 173, a title of a clip is only disclosed, but a file representing information in the clip is not completely disclosed. That is, information corresponding to a title name of the present invention is taught by *Nakata*, but the scene description file which describes a scene inside a video file and is different from the title name, is not completely taught.

As to the third element (3) of claim 1, the Examiner submits that it is disclosed in paragraph 180 of *Nakata*. However, in the paragraph 180, an in-point time code display column

111 and an out-point time code display column 113 are only disclosed, but "means for outputting a time information sequence existing before and after the current playback time of the video within time information described in the scene description file" of the present invention is not taught by *Nakata*.

Applicants specifically ask the Examiner to point out where this feature is disclosed in *Nakata*, if the Examiner believes it is disclosed in the reference.

Regarding the fifth element (5) of claim 1, the Examiner contends this element is also disclosed in paragraph 180. *Nakata* does not appear to disclose the renewing feature of the element "by synchronizing with the playback time of the video." Applicants respectfully submit that the "renewing" feature required in the claim is not disclosed by *Nakata* in paragraph 180 as the Examiner contends.

As *Nakata* appears to be directed toward a video editing system, particularly in a broadcast system environment, it is not concerned with "renewing the display of time information sequence and the still image sequence" as required in claim 1.

Particularly, in paragraphs 181 to 186, *Nakata* discusses editing operations which discuss reproducing a file in which the file can be searched via a "slider portion" or "jog shuttle portion." The slider portion appears to let the user go to any position in the file by moving the slider. With the jog shuttle portion, the editor can vary the search speed of the device in the range from -50 times speed to +50 times speed. See paragraphs 183 and 184.

Nakata appears to search a video by using a “slider” or a “jog shuttle.” The claimed invention, however, allows a user to preview still frames of video and requires a means for renewing the display of the time information sequence and the still image sequence. See for example figures 3A, 3B, 4A and 4B. *Nakata* does not disclose this feature, renewing the time information and still image sequences. *Nakata* appears to disclose an entirely different way of viewing and finding the correct video image.

Furthermore, as indicated above, a human being **cannot** be used to anticipate this feature.

Dependent Claims 2, 3, 7, 8 and 10:

As claims 2, 3, 7, 8 and 10 each depend upon independent claim 1, the arguments presented above also apply to the dependent claims.

Independent Claim 4:

Independent claim 4 requires:

means for delivering a video data related to the designated video file from a server at a constant transmission rate; and

means for delivering a scene description data which describes the scene of the video file from the server by synchronizing with the video data at a constant transmission rate.

The Examiner contends these features are disclosed by *Nakata* in paragraphs 251 and 264. Applicants respectfully traverse the Examiner’s rejection. The second element of claim 10 requires delivering scene description data by synchronizing with the video data at a constant rate. Applicants respectfully submit that this feature is not disclosed or fairly suggested by the *Nakata* reference.

Paragraph 251 of *Nakata* appears to describe how a video signal is input to the “matrix switcher portion 3B of the editing processing unit 3.” Nowhere does *Nakata* make reference to any scene description data as required by claim 4.

Paragraph 264 appears to describe how the “CPU 21 searches a video material recorded in the selected source file.” Nowhere does *Nakata* make reference to any scene description data as required by claim 4.

In fact, claim 4 of the present application appears to be directed toward a different invention than the *Nakata* reference. Claim 4 requires a “video delivery unit” which delivers video data **and** scene description data. *Nakata* on the other hand, does not appear to disclose or suggest delivering “scene description data.” As *Nakata* is directed toward an editing system for broadcast stations, there does not appear to be any need to deliver “scene description data” because once the program is edited, just video data will be output.

Independent Claim 13:

Independent claim 13 requires:

A video playback unit of a plurality of videos comprising:

¹video description file processing means for reading in a video description file of a designated video group;

²main video playback means for playing back a first main video file designated by the video information described in the video description file;

³proxy video playback means for playing back a second proxy video file designated by the video information described in said video description file; and

⁴display means for displaying the first main video and the second proxy video played back by said main video playback means and proxy video playback means;

⁵wherein said proxy video file is small in a file size or a coded bit rate in contrast to said main video file.

Regarding each element of independent claim 13, the Examiner contends that it is disclosed by *Nakata* in paragraph 184. Applicants respectfully traverse the Examiner's rejection. In paragraph 184, *Nakata* discusses the "jog shuttle" operation of the device (as mentioned above).

Regarding the first element (1) of claim 13, neither this paragraph, nor another paragraph in *Nakata* discloses the means for reading in a video description file *of a designated group*, as required in claim 13. Here *Nakata* appears to disclose the operation of the jog shuttle, which appears to be an editing tool that allows the editor to change the speed of the video. No mention is made of a description file of a designated video group, or the means to read in the file name thereof.

Regarding the second element (2) of claim 13, a video playback means for playing back a video designated by the information described in the video description file, Applicants respectfully submit that *Nakata* does not disclose this feature. Paragraph 184 does mention a reproduction button of the jog shuttle portion, however, no mention is made of playing back the video by *designating information from the video description file*. Emphasis added.

The third element (3) requires a proxy video playback means for playing back a second video. Again, as mentioned above, no mention is made of playing back a video by *designating*

information from the video description file. A fortiori, no mention is made of playing back a *second* video by designating information from the video description file.

The fifth element (5) requires that the proxy video file is small in size or a coded bit rate in contrast to the main video file. Applicants respectfully submit that *Nakata* does not disclose any sort of proxy video, including one that is smaller in size. As such, Applicants respectfully traverse the Examiner's rejection.

Independent Claim 16:

In rejecting claim 16, the Examiner has specifically relied upon paragraphs 172 and 176 of *Nakata*.

The second element of claim 16 requires a **proxy** video playback means for playing back the **proxy** video files designated by the information described in the video description file. Paragraph 176 of *Nakata* appears to disclose how an editor would select videos from the log window and place them in the program window in the order they are to be played. Each of the videos in the log window may have a title which describes the video.

An example of a proxy video is shown in figures 14A and 14B of the present invention, reference character 2. As shown in the figures, a proxy video is minor (i.e. not the main) video.

Applicants respectfully submit that *Nakata* does not disclose or fairly suggest any feature relating to playback of two videos, a main video and a proxy video. Therefore, the "proxy" playback means also does not appear to be disclosed by the *Nakata* reference.

The third element of claim 16 requires a means for selecting one video file from the displayed proxy video file. As indicated above, the *Nakata* reference does not refer to any sort of proxy video file.

The fourth element of claim 16 requires a means for changing the selected proxy video file to the playback display of the main video file. As indicated earlier, *Nakata* does not disclose any “proxy” video capability. As such, *Nakata* cannot disclose switching the playback display of the proxy and main video files. As such, Applicants respectfully traverse the Examiner’s rejection.

Independent Claim 17:

Independent claim 17 requires some features similar to those of claims 13 and 16. The arguments presented above regarding these features should also apply to claim 17. Furthermore, as indicated above, *Nakata* does not appear to disclose any “proxy video” feature. As such, this requirement of the present application should not be disclosed by the *Nakata* reference.

Independent Claim 19:

As independent claim 19 contains many of the same features as those discussed in independent claims 13, 16 and 17, the same arguments as applied to those claims also apply to claim 19. Specifically, the “proxy video” feature of independent claim 19 is not disclosed in the *Nakata* reference. As such, Applicants respectfully traverse the Examiner’s rejection.

Independent Claim 25:

Independent claim 25 is similar to independent claim 4. As mentioned in claim 4, the present application is directed toward a different invention than the *Nakata* reference. Claim 25 requires a “video delivery unit” which delivers the main video file and the proxy video file **and additionally** delivers a scene description file. *Nakata* on the other hand, does not appear to disclose or suggest delivering “scene description data.” Furthermore, *Nakata* does not appear to disclose the “proxy video” as the Examiner contends.

The Examiner contends these features are disclosed in paragraphs 224 and 264. It appears that paragraph 224 is directed toward figure 18 and device icons. The appropriate icon will be indicated depending from what source the material is coming from; i.e. server, local storage, VTR, etc. With this disclosure, the Examiner contends that the first element of claim 25 is disclosed. However, the first element of claim 25 requires delivering a designated **video description file** from a server. Paragraph 224 simply appears to be disclosing materials and events edited from a source drive. Applicants respectfully submit that *Nakata* does not support the Examiner’s assertion that it delivers from a server a video description file, as required by claim 25.

As *Nakata* is directed toward an editing system for broadcast stations, there is not any need to deliver “scene description data” because once the program is edited, only video data appears to be the output.

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Response under 37 C.F.R. §1.116
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In view of the aforementioned remarks, Applicants submit that the claims are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP


Dennis M. Hubbs

Attorney for Applicants
Registration No. 59,145
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

DMH/mra